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I hereby certify that this paper, together with all enclosures identified herein, are being deposited with the United States Postal Service as first class mail, addressed to the Assistant Commissioner for Patents, Washington D.C. 20231, on the date indicated below.

June 8, 2001.

Date

  
Jacki R. Buckley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit : 1745  
Examiner : C. Chaney  
Applicant : John C. Nardi  
Appln. No. : 09/213,544  
Filed : December 17, 1998  
For : ALKALINE CELL HAVING A CATHODE INCORPORATING  
ENHANCED GRAPHITE

Assistant Commissioner for Patents  
Washington D.C. 20231

TRANSMITTAL OF APPELLANT'S REPLY BRIEF

Enclosed herewith are the original and two copies of Appellant's Reply Brief for the above-identified application.

If any fees are required, please charge Deposit Account No. 05-1325. A duplicate of this transmittal is attached.

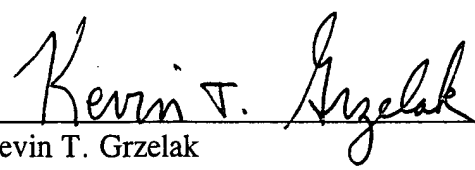
Respectfully submitted,

JOHN C. NARDI

By: Price, Heneveld, Cooper,  
DeWitt & Litton

June 8, 2001.

Date

  
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Atty. Docket No. EVE01 P-565 (SP-0649.1)

#16/ Apply  
Brief  
6/20/01  
H. Butler

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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APPELLANT'S REPLY BRIEF IN RESPONSE TO  
EXAMINER'S ANSWER UNDER 37 C.F.R. §1.193(b)

I. INTRODUCTION

This Reply Brief is filed under 37 C.F.R. §1.193(b) in reply to the Examiner's Answer dated April 10, 2001, regarding the above-identified application. A Notice of Appeal was filed on November 14, 2000, followed by the filing of the Appeal Brief filed on January 16, 2001. The points addressed in this Reply Brief focus primarily on the points of argument raised in the Examiner's Answer.

II. REQUEST FOR ORAL HEARING

Counsel for Applicants/Appellants has filed herewith, in a separate paper, a Request For Oral Hearing under 37 C.F.R. §1.194. The requisite fee set forth in 37 C.F.R. §1.17(g) is accompanied in the Request For Oral Hearing.

III. ARGUMENT AND REPLY REGARDING §103 REJECTIONS

The Examiner has rejected claims 1-13 and 15-21 as being unpatentable over Mototani et al. (U.S. Patent No. 5,482,798). The Examiner has raised several points of arguments with regard to the rejection in the Examiner's Answer. These arguments are respectfully traversed.

The Examiner raises the argument that because the processes for forming expanded graphite disclosed by Appellant in the prior art are similar, the materials produced will be similar, and thus have similar physical properties, including kerosene absorption values. This is

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not necessarily true. The Examiner has taken the position that Appellant must show distinctions between the expanded graphites disclosed by Mototani et al. and those of Appellant's instant invention, when, in fact, Mototani et al. does not provide ample disclosure to make a comparison.

MPEP §2112 provides "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities." The MPEP also provides that the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The MPEP further states that the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product.

Appellant is of the position that the Examiner clearly has not demonstrated that the expanded graphite employed in the electrochemical cell of Mototani et al. necessarily possesses the kerosene absorption characteristics recited in Appellant's claims. Mototani et al. does not disclose any specific kerosene absorption characteristics, as acknowledged by the Examiner. Nor does Mototani et al. teach or even suggest the relevance, importance, or desirability of selecting expanded graphite particles having a kerosene absorption value within Appellant's claimed range. It is submitted that the Examiner is impermissibly relying on mere probability or possibility to establish inherency as a basis for the rejection. The Examiner has not provided a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristics necessarily flow from the teachings of the Mototani et al. reference. Absent such a basis or technical reasoning, the Examiner has failed to meet the burden for establishing a *prima facie* case of obviousness.

The Examiner also raised the argument that Appellant's Declaration does not establish parameters of the expanded graphite disclosed by Mototani et al. Appellant has submitted evidence by way of a Declaration to illustrate that kerosene absorption properties of expanded graphite may vary from one sample of expanded graphite particles to another, and thus expanded graphite particles exhibit different characteristics. Various factors may determine the

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characteristics of expanded graphite particles including the starting graphite material and variances in the processing of the material, which can affect the resultant kerosene absorption value. Thus, Appellant has established that the expanded graphite employed in the electrochemical cell in Mototani et al. does not necessarily possess the kerosene absorption characteristics recited in Appellant's claimed invention.

The Examiner further raised the argument that the record fails to show any distinction between the expanded graphite disclosed in Mototani et al. and Appellant's expanded graphite. It is submitted that the Examiner is applying the wrong test. Appellant attempted to make and test expanded graphite particles according to the description set forth in Mototani et al., but determined that not enough of a description was provided in Mototani et al. to make a definite testable product. Appellant need not establish that the kerosene absorption parameters of Mototani et al. are different. It is the Examiner's burden to show that the claimed characteristics necessarily flow from the teachings of the prior art. Thus far, the Examiner has failed to meet this burden.


#### IV. CONCLUSION

For the foregoing reasons, in addition to those proffered within Appellant's Appeal Brief, the Examiner's rejection should be reversed and claims 1-13 and 15-21 allowed at the earliest possible date.

Respectfully submitted,

JOHN C. NARDI

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DeWitt & Litton

  
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June 8, 2001.  
Date

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Atty. Docket No. EVE01 P-865 (SP-0049.1)

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I hereby certify that this paper, together with all enclosures identified herein, are being deposited with the United States Postal Service as first class mail, addressed to the Assistant Commissioner for Patents, Washington D.C. 20231, on the date indicated below.

June 8, 2001.  
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*Jacki R. Buckley*  
Jacki R. Buckley

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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ENHANCED GRAPHITE

Assistant Commissioner for Patents  
Washington D.C. 20231

Dear Sir:

**REQUEST FOR ORAL HEARING PURSUANT  
TO 37 C.F.R. §1.194(b)**

**1. REQUEST FOR ORAL HEARING**

Applicants hereby request an oral hearing of the Appeal in this application.

**2. TERM FOR REQUEST**

The Examiner's Answer mailed April 10, 2001, and the term for filing the request is two months from that mailing date.

**3. STATUS OF APPLICANTS**

This application is on behalf of other than a small entity.

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Appln. No. : 09/213,544  
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4. **FEE FOR REQUEST FOR ORAL HEARING**

Pursuant to 37 C.F.R. §1.17(g), the fee for the request for oral hearing is \$270.

5. **TOTAL FEE DUE**

The total fee due is:

Request for oral hearing \$270

6. **FEE PAYMENT**

A check in the amount of \$270 is enclosed.

7. **FEE DEFICIENCY**

If any additional fees are required, please charge Deposit Account No. 05-1325. A duplicate of this transmittal is attached.

Respectfully submitted,

JOHN C. NARDI

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